

REMARKS

The present Amendment is in response to the Office Action dated December 10, 2003 in reference to the above-identified application. The Examiner set a shortened statutory period for reply of three (3) months, making the present Amendment due by March 10, 2004. Filed concurrently herewith is a request for a three-month extension of time so that the present Amendment is due by June 10, 2004.

In the Office Action, claims 1-6 and 8-34 are pending and have been rejected by the Examiner. More specifically, claims 1-4, 8-12, 24-27, and 30-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by G.B. Patent No. 2 228 791 to Thurlow. Additionally, claims 5, 6, 13-18, 20-23, 28, and 29 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Thurlow either alone or in combination with either U.S. Patent No. 5,359,988 to Hait, U.S. Patent No. 2,154,305 to Goerl, or both.

Before addressing the rejections to the claims, Applicant notes for the Examiner's attention that as requested in the first office action, Applicant has amended the paragraph of the specification on page 15, beginning on line 20. Applicant believes that the awkward wording noted by the Examiner has been addressed with the revisions shown above.

Turning now to the claims, Applicant notes that independent claims 24, 28, 30, and 33 have been amended in an effort to address the Examiner's rejections. Applicant has also made a technical amendment to claim 27 to correct a typographical error such that it now depends from independent claim 26.

Amendment of Claims 24, 25, and 30

Independent claims 24, 25, and 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Thurlow reference. In general, each of these claims has been amended to recite that the fire pan and the base are adapted to be securable to one another. As amended, claim 24 recites that the fire pan is adapted to be “releasably secured to said base and supported thereby when in the assembled state.” Similarly, claim 25 has been amended to further recite the step of “securing said fire pan to said base such that the interior of said fire pan is upwardly opening.” Finally, claim 30 has been amended to recite “said base and said fire pan being securable to one another.” Applicant believes that amending claims 24, 25, and 30 in this way addresses the Examiner’s 102(b) rejection and that these claims, as well as claim 31, which depends from claim 30, are now in condition for allowance.

In support of Applicant’s position that these claims, as amended, are now in condition for allowance, Applicant notes that in the Office Action, the Examiner acknowledged that “Thurlow does not recite a base and fire pan being securable to one another....” (Office Action p.13, lines 1-3). In further support of the allowance of independent claims 24, 25, and 30 as amended, Applicant asserts that one of ordinary skill in the art would not be motivated to modify the Thurlow apparatus so as to have a fire pan that is releasably secured to the base either in view of Thurlow alone, or in combination with any of the references made of record in this case.

As identified by the Examiner on page 5 of the Office Action, the fire pan of the Thurlow apparatus is tray 11 and the base is “that shown below 11a in figure 2”. (Office Action p.5, lines 12-14; See also pp. 3, 6-9; 12, 14, and 15). As discussed in Thurlow, “tray 11 stands on legs 11a with the burner head being accommodated in

the space between the tray and the bottom of legs 11a". (page 4, lines 29-32). Elements 11a are shown in both Figures 2 and 3 of the Thurlow reference. Figure 2 is a side view of the Thurlow apparatus and from this figure it may further be understood that elements 11a and the lines below elements 11a are formed as one integral piece. Arguably, Figure 2 further shows that elements 11a are formed as an integral piece of tray 11.

If the base, as identified by the Examiner, is the horizontal line below elements 11a, it would follow then, that in order for the base to be releasably secured to the fire pan, the line beneath 11a would have to be separated therefrom and then modified so as to be releasably secured to the tray 11. Since the line below 11a is integral to elements 11a, which in turn, arguably, is integral to tray 11, Applicant submits that such a modification would require a substantial reconstruction and redesign of the Thurlow apparatus. None of the references made of record are sufficient to suggest or even motivate one of ordinary skill to reconstruct the Thurlow apparatus in this way.

Applicant additionally submits that breaking apart the line beneath 11a from elements 11a may ultimately compromise the strength and ability of legs 11a to adequately support the weight of tray 11, its contents, and ceramic fiber coals or logs 13. This would render legs 11a unfit for their intended purpose. It should be noted that if a proposed modification to a reference would render the device being modified unsatisfactory for its intended purpose, then there is necessarily no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The lack of motivation to reconstruct Thurlow in this way becomes ever more apparent with reference to Figure 3 of the reference. Separating the line below 11a would essentially require a separation of the bottoms of legs 11a and then modifying these small pieces to be releasably securable to tray 11. A person of ordinary skill in the art would have no desire to make this modification.

Amendment of Claim 33

Independent claim 33 was rejected under 35 U.S.C. § 102(b) as being anticipated by the Thurlow reference. Applicant has amended the claim to additionally recite “a detachable spacer adapted to be supported by said base and to support said fire pan when in the assembled state.” Applicant submits that Thurlow does not teach a detachable spacer. In the Office Action, the Examiner identifies the “spacer” of the Thurlow apparatus as legs 11a, the fire pan as tray 11, and the base as the lines beneath 11a. As mentioned above Figure 2 appears to show legs 11a as an integral part of both tray 11 and the base. Arguably, a substantial amount of reconstruction to the Thurlow apparatus would have to be undertaken to make legs 11a detachable from tray 11 and the base.

Further, there would be no desire to make legs 11a detachable from tray 11 because the Thurlow apparatus is not designed to be portable or stored when in not in use, which would be the advantages associated with having a detachable spacer. Thurlow teaches that the apparatus is “designed to be a free standing open fire or can be fitted in a closed stove, convection box, or central heating stove. In a closed stove, it is designed to burn without sooting and could be used in Class 1 or Class 2 chimneys.” (Page 2, lines 22-26). Based upon this part of the description, the Thurlow reference teaches a gas fire apparatus designed to be a stationary unit that

provides both heat and the aesthetic appearance of a real solid fuel fire for use within the home. Accordingly, there would be no desire to modify the apparatus to make it portable or easy to store. Based on the foregoing reasons then, Applicant believes that claim 33 is in complete condition for allowance.

Rejection of Claims 6, 21, and 29 and Amendment of Claim 28

The Examiner has rejected claims 6, 21, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Thurlow in view of Hait and/or Goerl. Applicant respectfully disagrees with these claim rejections. Assuming, *arguendo*, that one of ordinary skill in the art would be motivated to provide the Thurlow apparatus with a lid, neither Hait nor Goerl would motivate one of ordinary skill to modify tray 11 to include an upper rim having an inwardly projecting shoulder portion that extends continuously around the fire pan.

For a proper rejection under 35 U.S.C. § 103 all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (“All words in a claim must be considered in judging patentability of that claim against the prior art.”). Here, in order to rise to the level of a *prima facie* case of obviousness, the Examiner must prove that one of ordinary skill would have been motivated by the teachings of Hait and/or Goerl to modify Thurlow to include a fire pan having an upper rim having an inwardly projecting shoulder portion that extends continuously therearound.

Hait has a fire pan 20 that includes a “flanged rim 20b”. (Column 4, lines 40-42;). Nothing in Hait, either in the specification or the figures, depicts flanged rim 20b as having an inwardly projecting shoulder portion. The only element of the Hait

cooking unit that Applicant was able to find as having a rim with a shoulder portion is that pertaining to grill adapter 35. However, grill adapter's shoulder portion is *outward* rather than inward. As described, "grill adapter 35 includes an outwardly, inclined annular flange rim 35a that seats on the flange rim 20b of the firebox 20." (Column 5, lines 50-52). Accordingly, then, assuming one of ordinary skill in the art would be motivated to modify tray 11 based upon the teachings of Hait, Thurlow would merely include a flanged rim and not a rim having an inwardly projecting shoulder.

With reference now to Goerl, the apparatus disclosed therein is a cooking unit with "pan elements 12 and 13 and 14." (Column 1, lines 54-55). Pan element 12 has an "outturned bead 25." (Column 2, lines 15-16). Pan element 13 has an "outturned bead 35". (Column 2, lines 32-34). Pan element 14 has an "outturned bead 53". (Column 3, lines 46-47). As shown, outturned beads 25, 35, and 53 extend continuously around the upper portion of the respective pan elements. However, no where in the description or in the figures are outturned beads 25, 35, and 53 described or shown as having an inwardly projecting shoulder. Accordingly, then, assuming one of ordinary skill in the art would be motivated to modify tray 11 based upon the teachings of Goerl, Thurlow would merely be modified to include a tray 11 with an outturned bead. Such a combination of elements does not rise to a *prima facie* case of obviousness and Applicant believes that claims 6, 21, and 29 recite allowable subject matter.

Applicant further notes for the Examiner's attention that independent claim 28 has been amended to include the recitation of claim 29 resulting in the cancellation

of claim 29. Based on the foregoing arguments in favor of the allowance of claim 29, Applicant believes that claim 28, as amended, is now in condition for allowance.

Rejection of claims 1, 17, and 34

Applicant respectfully disagrees with the Examiner's position that claims 1 and 34 are anticipated by Thurlow. A 35 U.S.C. § 102(b) rejection requires that the reference teach each and every element of the claim. *See Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Section 2111.01 of the MPEP states "During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. M.P.E.P. § 2111.01 (8th ed, rev. 1; August, 2001), *citing, In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

Both claims 1 and 34 recite "a spacer adapted to be interposed between said fire pan and said base." Thurlow does not teach such a spacer interposed between the fire pan and the base. The word "interposed" is defined as in The American Heritage Dictionary Of The English Language as:

- 1a. To insert or introduce between parts.
- 1b. To place (oneself) between others or things.

Accordingly, to anticipate either claims 1 or 34, Thurlow would have to teach a spacer that is adapted to be inserted or introduced between the fire pan and the base or placed therebetween. In rejecting claim 1, the Examiner has identified the base as shown by "horizontal lines below elements 11a in figure 2"; the fire pan as tray 11 and the spacer as element 11a. (Office Action p. 3). Elements 11a are described in Thurlow as legs. Further, as discussed in some detail above, both

Figures 2 and 3 show the base (horizontal line beneath 11a) as an integral part of legs 11a. Arguably, too, based on Figure 2, legs 11a form an integral part of tray 11.

Thurlow does not teach a spacer adapted to be interposed between the fire pan and the base. Legs 11a simply cannot be inserted, introduced, or placed between that which it already forms an integral part thereof – namely the base and arguably the tray. Accordingly, Applicant believes that the Examiner has misapplied the Thurlow reference as anticipating claims 1 and 34 and believes that these claims are in condition for allowance. As such, claims 2-6 and 8-14, which depend from claim 1 are also in condition for allowance.

Along this same vein, claim 17 was rejected under 35 U.S.C. § 103 as being unpatentable over Thurlow stating that the Thurlow reference teaches a spacer “having a hollow interior and interposed between the base and the fire pan.” For the reasons asserted above, Thurlow does not teach a spacer interposed between the base and the fire pan nor would one of ordinary skill be motivated by Thurlow to reconstruct the apparatus so as to be able to insert, introduce, or place legs 11a between the base and the fire pan.

Rejection of claim 12

Applicant respectfully disagrees with the Examiner’s position that claim 12 is anticipated by Thurlow because the reference does not directly or implicitly teach a fire pan and a base that are “of substantially the same size and shape.” Again, the fire pan of the Thurlow apparatus is tray 11 and the base is a “horizontal line” positioned shown below 11a in figure 2. In order for the Thurlow reference to anticipate this claim, the horizontal line would need to be of substantially the same

size and shape as tray 11. Applicant submits that this is not the case and that the Examiner has misapplied this reference as anticipating this claim.

The horizontal line below 11a wholly lacks the sufficient dimensions to be considered substantially the same size and shape as tray 11. Tray 11 is of sufficient depth to contain both the burner and the vermiculite whereas the base appears to be a plate, if not the foot of the leg 11a. Arguably, to modify the Thurlow apparatus to include a base of substantially the same size and shape would require the elimination of elements 11a as well as the horizontal line beneath them and a wholly new construction to arrive at Applicant's invention. None of the references made of record is sufficient to suggest or even motivate one of ordinary skill to reconstruct the Thurlow apparatus in this way. Nor could any of the references be combined with Thurlow to arrive at Applicant's invention without using impermissible hindsight. Accordingly, Applicant believes that claim 12 contains allowable subject matter.

Rejection of Claims 15 and 23

Claims 15 and 23 were rejected under 35 U.S.C. § 103(a) over Thurlow in combination with Hait and Goerl. Applicant respectfully disagrees with these claim rejections because Thurlow does not teach a base shell having a selected geometric configuration and size and a base interior, as recited in both of these claims.

Throughout the Office Action, the Examiner identifies the base as "that shown below elements 11a" and the spacer as 11a, located "between the fire pan and the base." (Office Action p. 3). Accordingly, only that which is positioned below elements 11a is the base and that which is located between the fire pan and the base is the spacer.

With this legend of elements in mind, the horizontal line below elements 11a is not constructed as a base shell. Further, the horizontal line below elements 11a does not have a “base interior”. The Examiner identifies the base interior as that *above* the horizontal line – but this region has also been called out as the spacer and therefore cannot now arbitrarily be assigned as a part of the base for the purposes of rejecting this claim. For example, in rejecting claim 15, the base interior is above the base while in the analysis of the rejection of claim 23, the “interior” becomes a spacer formed as a hollow connector.

Additionally, claim 15 recites that the base and the fire pan are securable to one another. As argued above to support the amendments to independent claims 24, 25, and 30, Applicant submits that neither Hait nor Goerl could be used to arrive at Applicant’s invention with the impermissible use of hindsight reasoning. For these reasons, Applicant submits that claim 15 is in condition for allowance and that dependent claims 16-21, which depend therefrom are also in condition for allowance.

Claim 23 additionally recites that the spacer is “interposed between” the fire pan and the base. For the reasons offered above with respect to the arguments submitted in favor of claims 1, 17, and 34, Applicant further submits that Thurlow, neither alone or in combination with the references made of record, teach or otherwise render obvious, Applicant’s invention as claimed in claim 23. Furthermore, as more fully described below, Applicant does not believe that one of ordinary skill in the art would provide the Thurlow apparatus with a lid.

Rejection of Claim 28, addition of New Claim 36

Applicant respectfully disagrees with the Examiner’s rejection of claim 28, which was rejected under 35 U.S.C. § 103(a) as being unpatentable over Thurlow in

view of Hait and Goerl. In rejecting this claim, the Examiner acknowledges that Thurlow “does not explicitly recite a lid sized and adapted to enclose the pan interior when in the assembled state.” (Office Action p. 15). However, she reasons that since both Hait and Goerl teach the use of a lid, “it would be obvious to one with ordinary skill in the art to modify the invention of Thurlow to include a lid as taught by Hait and Goerl for the purpose of enclosing the pan.” Applicant respectfully disagrees with this reasoning.

First, both Hait and Goerl disclose cooking apparatuses. It comes as no surprise then that each would include a lid because many things that are cooked are done so with the use of a lid. However, the Thurlow apparatus is not a cooking apparatus. The Thurlow apparatus is “a solid fuel or log effect open gas fire” that includes “a number of refractory bodies to represent coals or logs”. (Page 1, lines 1-6). Further, as taught the Thurlow apparatus is “designed to be a free standing open fire or can be fitted in a closed stove, convection box, or central heating stove. In a closed stove, it is designed to burn without sooting and could be used in Class 1 or Class 2 chimneys.” (Page 2, lines 22-26).

The Thurlow apparatus has absolutely no use for a lid that is adapted to enclose the pan interior. One of the attributes of the Thurlow apparatus is to provide the effect of an open fire. A lid would completely conceal the effect that the Thurlow apparatus is trying to offer. Furthermore, as argued above, the Thurlow apparatus appears to be primarily a stationary apparatus that may be placed in a closed stove, convection box, or central heating stove. A lid would serve no usefulness to the apparatus once disposed as such. Accordingly, it would not be obvious to one of ordinary skill in the art to modify the Thurlow apparatus so as to have a cooking lid.

Applicant has rewritten original independent claim 28 as new independent claim 36. For the reasons noted above, Applicant believes that new claim 36 is in complete condition for allowance.

New Claim 35

The Examiner will note that new claim 35 is a dependent claim off of the method claim 25. New claim 35 simply recites that the particulate matter is vermiculite.

Due to this Amendment, a new filing fee calculation is provided, as follows:

Maximum Total Claims This Amendment		Total Claims Previously Paid For	
34	-	34	= 0 x \$ 9.00 = \$0.00
Total Independent Claims Per This Amendment		Maximum Independent Claims Previously Paid For	
10	-	9	= 1 x \$43.00 = \$43.00
Additional Filing Fee Due			\$43.00

Accordingly, our check no. 18356 in the amount of \$43.00 is enclosed. The Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No. 13-1940.

Based on the foregoing, Applicant submits that the present application is in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the Applicant at the telephone number listed below.

Respectfully submitted,

TIMOTHY J. MARTIN, P.C.

By: 

Timothy J. Martin, #28,640

Michael R. Henson, #39,222

Rebecca A. Gegick, #51,724

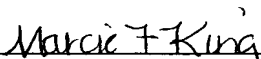
9250 West 5th Avenue, Suite 200

Lakewood, Colorado 80226

(303) 232-3388

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that the foregoing **AMENDMENT (27 pages), CHECK NO. 18356 IN THE AMOUNT OF \$43.00, REQUEST FOR A THREE MONTH EXTENSION OF TIME (2 pages) and CHECK NO. 18355 IN THE AMOUNT OF \$475.00** is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10th day of June, 2004.



Marcie F. King